

PATENT APPLN. NO. 10/593,483
RESPONSE UNDER 37 C.F.R. §1.111

PATENT
NON-FINAL

REMARKS

Drawings

The Office has noted that reference numbers 220 and 250 in "Fig. 5" (sic, Fig. 9) are not mentioned in the description in the specification.

Applicants have amended the description of Fig. 9 in paragraph [0028] of the specification to provide a description of reference numbers 220 and 250. The description of the corresponding elements of the syringe in Fig. 2 identified with reference numerals 20 and 50 is believed to provide support for the amendment to the specification.

Claim Rejections - 35 USC § 112

The Office is correct that the limitation "A + B + C > D" in claim 9 should be --A + B + C < D--. Claim 9 has been amended to correct this error.

Claim Rejections - 35 USC § 102

Claims 1-4, 6 and 9-10 are rejected as being anticipated under 35 U.S.C. § 102 by Ohtani et al., U.S. Patent No. 5,891,087 ("Ohtani"). Claims 1 and 10-11 are rejected as being anticipated under 35 U.S.C. § 102 by Higashikawa et al., U.S. Patent No. 5,851,200 ("Higashikawa").

The position of the Office regarding the anticipation of the

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rejected claims by the cited references is not clear. A rejection for anticipation under 35 U.S.C. § 102 requires that a single reference disclose each of the elements, or limitations, of a claim. However, the Office does not identify where each of the limitations of the rejected claims are disclosed in the cited references. For example, in explaining the rejection of claim 1 based on Ohtani, the Office does not explain where Ohtani discloses the limitations that the intermediate gasket includes "a seal part contacting an inner wall of the barrel and liquid-tightly partitioning the front chamber and the rear chamber, and a bypass communication passage providing communication between the front chamber and the rear chamber in cooperation with the bypass." The Office fails to explain where these same limitations in claim 1 are disclosed in Higashikawa.

The Office also appears to ignore limitations in some of the dependent claims.

It is not clear to applicants whether the Office is taking the position that these limitations cannot be understood or, for some reason, are not entitled to weight or whether the Office has overlooked the limitations. Neither the syringe of Ohtani nor the syringe of Higashikawa is believed to include an intermediate gasket which includes the above-identified elements.

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Applicants also note that neither Ohtani nor Higashikawa appears to disclose an intermediate gasket which includes "a seal part contacting an inner wall of the barrel and liquid-tightly partitioning the front chamber and the rear chamber, and a bypass communication passage providing communication between the front chamber and the rear chamber in cooperation with the bypass."

In order to expedite the prosecution of the present application, the Office is respectfully requested, if it maintains the 35 U.S.C. § 102 rejections in a further Action, to specifically identify where each of the elements of the rejected claims is disclosed in Ohtani and Higashikawa.

Notwithstanding that neither Ohtani nor Higashikawa is believed to disclose each of the elements of the rejected claims, claim 1 has been amended to recite that "an axial length of the intermediate gasket is longer than that of the bypass, and when an axial length of the bypass is a_1 and an axial effective length of the seal part is b_1 , $a_1 > b_1$."

The latter limitation, i.e., when an axial length of the bypass is a_1 and an axial effective length of the seal part is b_1 , $a_1 > b_1$, was originally recited in claim 2. Claim 2 has been canceled.

The former limitation, i.e., an axial length of the

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intermediate gasket is longer than that of the bypass, is supported by Figures 1-6 and 9-11 and by the description in paragraph [0005] of the specification, which describes a problem of a conventional two-component mixing type pre-filled syringe that has been overcome by the pre-filled syringe of the present invention. (See paragraph [0008] of the present specification). Specifically, paragraph [0005] describes:

"However, in the conventional two-component mixing type pre-filled syringe 3, since a seal part 871 is formed from a tip to a base end of the intermediate gasket 870 as shown in Fig. 20, in order that the liquid medicine L in the rear chamber 812 flow into the front chamber 811, an axial length of the bypass 813 must be longer than a total length of the intermediate gasket 870. For this reason, the length of the pre-filled syringe 3 becomes long."

(Emphasis added). As can be seen in the drawings and understood from the description of the present invention, in the present invention, the axial length of the intermediate gasket is longer than that of the bypass.

Neither Ohtani nor Higashikawa discloses a pre-filled syringe which meets the additional limitations added to claim 1 and for

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this reason also are insufficient to support a rejection of the claims for anticipation under 35 U.S.C. § 102.

Removal of the 35 U.S.C. § 102(b) rejections of the claims is believed to be in order and is respectfully requested.

Claim Rejections - 35 USC § 103(a)

The 35 U.S.C. § 103(a) rejections depend on the propriety of the 35 U.S.C. § 102 rejections. Since, as shown above, Ohtani and Higashikawa do not support the 35 U.S.C. § 102 rejections of claim 1, the claims which depend on claim 1, directly and indirectly, and which are rejected under 35 U.S.C. § 103(a) are *prima facie* patentable.

Removal of the 35 U.S.C. § 103(a) rejections is also respectfully requested.

Notwithstanding that the claims are believed to be patentable under 35 U.S.C. § 103(a), applicants note for the record that Hughes, U.S. Patent No. 6,554,792, cited in the rejection of claim 5, does not appear to be properly combinable with Ohtani.

Double Patenting

Claims 1, 10 and 11 are provisionally rejected for obvious-type double patenting ("ODP") over claims 1 and 2 of copending application Serial No. 11/652,001.

A terminal disclaimer is submitted herewith to overcome the

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ODP rejection.

The foregoing is believed to be a complete and proper response to the Office Action dated November 26, 2008, and is believed to place this application in condition for allowance.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to Deposit Account No. 111833.

In the event any additional fees are required, please also charge Deposit Account No. 111833.

Respectfully submitted,

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